

Claim 34 (New) The insulation material sheet of claim 26 wherein said markings are defined according to a definition selected from the group consisting only of definitions (a) and (b).

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Claim 35 (New) The insulation material sheet of claim 26 wherein said markings are defined according only to definition (a).

### REMARKS

The following remarks are believed to be fully responsive to the Office Action of December 3, 2002. In light of these remarks, reconsideration of the claim rejections is requested.

A request for continued examination and the corresponding fee are being filed herewith.

This application included 20 claims prior to this response. By way of this response, new claims 26-35 have been added.

Claims 1, 2, and 8-25 were rejected for three independent reasons. First, they were rejected for allegedly being obvious in light of U.S. Patent No. 4,866,905 issued to Bihiy et al. Second, they were rejected for allegedly being obvious in light of German patent DE 3713108A. Third, these claims were rejected for allegedly being obvious in light of European patent EP 795424 A1. Applicants submit that all three of these rejections are improper because no prima facie case of obviousness has been established.

In order to establish a prima facie case of obviousness, three basic criteria must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. Here, Applicants submit that at least the first and third requirements for a prima facie case of obviousness are not present.

With respect to the first requirement, the Examiner has concluded that:

It would have been a matter of obvious design choice to have provided any specific design motivated by the desire to provide user instructions for utilizing the structure or improving product aesthetics.

This rationale was used to justify each of the three rejections of the pending claims. Applicants submit, however, that this rationale does not provide any motivation for modifying the disclosures of any of these three references. Specifically, the Examiner's rationale is so broad that it would have precluded patent protection in the case of *In re Miller*, 164 USPQ 46 (C.C.P.A. 1969).

In the *In re Miller* case, the patent application was directed to a measuring cup that was specifically suited for measuring out fractional recipes. The measuring cup included marked indicia for measuring different fractions of recipes. For example, markings were included on the cup for measuring one half portions of a given recipe. For these markings, the line corresponding to, for example, one cup, actually corresponded to a volume of one half cup. The user of the measuring cup, therefore, used the one half recipe indicia in a manner that corresponded to the full volumes recited in the recipe. The end result would be only one half of the amount stated in the recipe.

The indicia on the measuring cup in the *In re Miller* case therefore provided a "specific design motivated by the desire to provide user instructions for utilizing the structure." The indicia were provided specifically to facilitate the use of the cup when confronted with situations in which the cook wanted to make only a fraction of the recipe. The Examiner's broad brush rationale that "any specific design" would have been obvious therefore would have rendered the subject matter of the *In re Miller* case obvious. However, the U.S. Court of Customs and Patent Appeals specifically stated that there was "a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio." Further, the court stated that it deemed "§102 and 103 to be satisfied." The stated rationale for the alleged obviousness of the pending claims therefore cannot stand because it is contrary to the *In re Miller* case.

The rejections for obviousness also cannot stand because the third element of a prima facie case of obviousness is missing. Nowhere has any prior art been identified which teaches or suggests all of the claim limitations of the pending claims. All three of the references cited by the Examiner disclose markings on insulation material in which the markings are solely oriented in a direction that is transverse to the longitudinal extent of the insulation material. No prior art has been cited that discloses any other types of markings. To the extent the Examiner is relying on knowledge "well known in the art," Applicants specifically traverse such alleged well known-

ness and request a citation to a specific piece of prior art. As mentioned in MPEP §2144.03, if the Applicant traverses an assertion by the Examiner that knowledge is well known in the art, a reference cited in support of the Examiner's position should be given. Accordingly, unless the prior art document can be located that discloses the use of non-perpendicular markings on an insulation sheet, Applicants submit that the third element of a prima facie case of obviousness is lacking.

For all of the foregoing reasons, the rejections of the claims should be withdrawn.

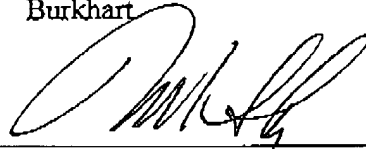
New claims 26-35 have been added to better define and more clearly recite aspects of the present invention. For the same reasons discussed above, these new claims are not properly rejectable in light of the three references cited in the Office Action of December 3, 2002. Accordingly, all of the pending claims of the application should be in a condition for allowance. A notice to such effect is requested.

Respectfully submitted,

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